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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Garry D. Gladstone

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STETINA BRUNDA GARRED & BRUCKER

75 ENTERPRISE, SUITE 250

ALISO VIEJO, CA 92656

EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/884,303	Applicant(s) GLADSTONE, GARRY D.	
	Examiner Ella Colbert	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-7 and 10-27 are pending in this communication filed 01/24/05 entered as Response After Non-Final and Request for Extension of Time.
2. Applicants' convincing argument has overcome the rejection of claims 10, 17, 19, and 24 under 35 U.S.C. 112, second paragraph and is hereby withdrawn.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6 and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by (US 6,477,647) Venkatraman et al, hereafter Venkatraman.

Claim 1. Venkatraman teaches, An automated method of communicating trade orders to a marketplace for financial instruments through an on-line trading account with a financial institution, the method comprising the steps of: (a) receiving, through the use of a computer, trade trigger criteria for use by market analysis software, the market analysis software being configured to electrically receive market data, the trade trigger criteria being related to the market data (col. 4, lines 37-43 col. 5, lines 20-41, and fig. 11); (b) accessing, through the use of a computer, the market analysis software to generate a trade decision using the trade trigger criteria and the market data (col. 9, lines 19-42, fig. 2 (24), fig. 7 (120), and fig. 9A-9C); and (c) automatically communicating, through the use of a computer, a trade order based upon the trade

decision to the marketplace via the on-line trading account (col. 10, lines 13-29, fig. 2 (24), and fig. 7 (120).

Claim 2. Venkatraman teaches, The method of Claim 1 wherein the market analysis software is hosted by an entity different than the financial institution (col. 5, lines 30-41 and col. 9, lines 12-18).

Claim 3. Venkatraman teaches, The method of Claim 1 wherein the on-line trading account is hosted at a web address accessible through a computer network (col. 1, lines 54-67).

Claim 4. Venkatraman teaches, The method of Claim 1 wherein the market analysis software is hosted at a web address accessible through a computer network (col. 9, lines 3-11, fig. 4, fig. 6, and fig. 7).

Claim 5. Venkatraman teaches, The method of Claim 4 wherein step (b) includes communicating the trade trigger criteria to the market analysis software via a computer network (col. 4, lines 37-51, fig. 2 (24), and fig. 11).

Claim 6. Venkatraman teaches, The method of Claim 1 wherein the market analysis software is hosted at a personal computer (col. 4, lines 39-43 and fig. 7 (120).

Claim 13. This dependent claim has a step that corresponds to claim 4 above and is rejected for the similar rationale as given above for claim 4.

Claim 14. This dependent claim has a step that corresponds to claim 5 above and is rejected for the similar rationale as given above for claim 5.

Claim 15. This dependent claim has a step that corresponds to claim 6 above and is rejected for the similar rationale as given above for claim 6.

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Claim 16. This dependent claim has a step that corresponds to claim 5 above and is rejected for the similar rationale as given above for claim 5.

Claim Rejections - 35 USC § 103

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 7-12 and 17-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,477,647) Venkatraman et al in view of (US 6,615,188) Breen et al, hereafter Breen.

Claim 7. Venkatraman failed to teach, The method of Claim 1 wherein the trade trigger criteria is based upon a status of the on-line trading account. Breen teaches, the trade trigger criteria is based upon a status of the on-line trading account (col. 1, lines 13-52, col. 8, 6-62, col. 10, lines 1-38, and fig.1 (40)). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the trade trigger criteria based upon a status of the on-line trading account and to modify in Venkatraman because such a modification would allow Venkatraman to make his own decisions as to trades and to call the discount brokerage with the trade information and after the trade is consummated to identify the cost of the security and debit the holder's cash account accordingly then update the holder's balances to show the purchased securities.

Claim 10. Venkatraman teaches, An automated system for communicating trade orders to a marketplace for financial instruments through an on-line trading account with a financial institution, the system comprising: a user interface configured to receive trade trigger criteria from a user (col. 4, lines 52-67, col. 9, lines 28-31, col. 10, lines 46-58, and fig. 7 (120)); and market analysis software in electrical communication with the user interface for receiving the trade trigger criteria therefrom, the market analysis software being configured to receive market data, the trade trigger criteria being related to the market data, the market analysis software being further configured to generate a trade decision in response to the trade trigger criteria and the market data (col. 7, lines 49-65, col. 8, lines 1-18, and col. 9, lines 19-42). Venkatraman failed to teach, a trading account interface in electrical communication with the market analysis software for

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receiving the trade decision therefrom, the trading account interface being configured to automatically communicate a trade order based upon the trade decision to the marketplace via the on-line trading account.

Breen teaches, a trading account interface in electrical communication with the market analysis software for receiving the trade decision therefrom, the trading account interface being configured to automatically communicate a trade order based upon the trade decision to the marketplace via the on-line trading account (col. 11, line 62-col. 12, line 27, fig. 1 (52), and fig. 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a trading account interface in electrical communication with the market analysis software for receiving the trade decision therefrom, the trading account interface being configured to automatically communicate a trade order based upon the trade decision to the marketplace via the on-line trading account and to modify in Venkatraman because such a modification would allow Venkatraman to have a user interface for executing a trading process with the order being aggregated with other customer orders to yield a total dollar amount for a particular stock.

Claim 11. Venkatraman teaches, The system of Claim 10 wherein the user interface is hosted at a web address accessible through a computer network (col. 1, lines 54-67).

Claim 12. Venkatraman failed to teach, The system of Claim 10 wherein the market analysis software is hosted by an entity different than the financial institution. Breen teaches, the market analysis software is hosted by an entity different than the

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financial institution (col. 7, lines 1-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the market analysis software is hosted by an entity different than the financial institution and to modify in Venkatraman because such a modification would allow Venkatraman to have an investor that is a person or business entity that opens an account for the purpose of investing in stocks, securities or other financial instruments through the operation of a trading server.

Claim 13. The system of Claim 10 wherein the market analysis software is hosted at a web address accessible through a computer network.

Claim 17. Venkatraman failed to teach, The system of Claim 10 wherein the market analysis software includes multiple market analysis software, each having a different analysis algorithm associated therewith. Breen teaches, wherein the market analysis software includes multiple market analysis software, each having a different analysis algorithm associated therewith (col. 8, line 18-col. 10, line 38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the market analysis algorithm associated therewith and to modify in Venkatraman because such a modification would allow Venkatraman to an investor account set up with each company for which the investor wants to do business with and to have each company to handle the paperwork for the investor. Setting up the investment account requires one type of software, trading requires another different software, and debiting the investor account requires another different software which is known by the skilled artisan.

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Claim 18. This dependent claim is rejected for the similar rationale as given above for claim 7.

Claim 19. This independent claim is rejected for the similar rationale as given above for claim 7, 10, 16, and 18.

Claim 20. This dependent claim is rejected for the similar rationale as given above for claim 11.

Claim 21. This dependent claim is rejected for the similar rationale as given above for claim 12.

Claim 22. This dependent claim is rejected for the similar rationale as given above for claim 21

Claim 23. This dependent claim is rejected for the similar rationale as given above for claim 13

Claim 24. This dependent claim is rejected for the similar rationale as given above for claim 17.

Claim 25. This dependent claim is rejected for the similar rationale as given above for claim 16.

Claim 26. This dependent claim is rejected for the similar rationale as given above for claim 14.

Claim 27. This dependent claim is rejected for the similar rationale as given above for claim 18.

Response to Arguments

8. Applicant's arguments filed 01/24/05 have been fully considered but they are not persuasive.

Issue no. 1: Applicant argues: the Office Action does not appear to show any teaching or suggestion with respect to "market analysis software" that is configured to receive "trade trigger criteria" and "market data" has been considered but is not persuasive. Response: It is interpreted in the broadest sense that the "trade trigger criteria" is the confirmation that the trade took place, the market data is the shown in figure 7 which is a trade detail with information about each trade made by the customer, and the software can be any software that can perform an analysis of a trade. "Market analysis software" per se is a design choice.

Issue no. 2: Applicant argues: the Office Action contends that step (b) is taught by the Venkatraman et al. reference with specific citation to col. 9, lines 19-42, fig. 2, item 24, fig. 7, item 120, and figures 9 (a)-(c) with no analysis shown regarding how any of the cited passages and figures disclose the claimed element, and the Office Action fails to show that the Venkatraman et al. reference teaches or suggests a step of accessing market analysis software to generate a trade decision using the trade trigger criteria and the market data has been considered but is not persuasive. Response: It is interpreted that when a customer accesses a website and completes a trade that this is a trigger and when the trade is transmitted within a period of time. It is unclear and vague as to what Applicant means by "trade trigger criteria". The Examiner interprets the "trade trigger criteria" broadly and as meaning when a customer submits their trade

at the website and the trade is transmitted over the system and a confirmation is received by the customer. As for the market analysis software, can be any analysis software that is capable of performing the function of analysis. Software is defined as computer programs, procedures, and possibly associated documentation and data pertaining to the operation of a computer system.

Issue no. 3: Applicant argues: Applicant asserts that the Office Action fails to show that the Venkatraman et al. reference teaches or suggests a step of “automatically communicating, through the use of a computer, a trade order based upon the trade decision to the marketplace via the on-line trading account” has been considered but is not persuasive. Response: It is interpreted that when the manager receives and reviews the response from each customer the manager can determine that the response was within a specified period of time and the response is analyzed and processed —“communicated through the user of a computer a trade order based upon a trade decision to a marketplace (a manager of trade orders) via an on-line trading account (even though the reference does not say the customer must have had an account prior to the trade in the mentioned database), however it is assumed the customer has some type of account to have the ability to trade. For example, in order to trade on-line with Sharebuilder the customer has to have an account.

Issue no. 4: Applicant argues: Applicant submits that the Venkatraman et al. reference is a fundamentally different system, namely, a trade confirmation system and no analysis is performed by the system as to recommend whether or when a trade should be made has been considered but is not persuasive. Response: It is not clear in

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the claim limitations that an analysis is performed by the system as to recommend whether or when a trade should be made. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Issue no. 5: Applicant argues: Neither the Venkatraman et al. reference or Breen et al. reference teaches or suggests utilization of market analysis software has been considered but is not persuasive. Response: Breen et al. does teach a brokerage system that executes customer orders with an internet or other connection, a user interface, and teaches software to operate the order terminal function on a general purpose personal computer in col. 7, lines 56-62.

Conclusion: The skilled artisan is presumed to know something more about the art than only what is disclosed in the applied reference/references. In other words, the person having ordinary skill in the art has a level of knowledge apart from the content of the references. In *re Bode*, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977); In *re Jacoby*, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). A conclusion of obviousness is established "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference." In *re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

The Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

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During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969). The court determined that to read a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim. "The court found that applicant was advocating the latter, e.g., the impermissible importation of subject matter from the specification into the claim.)<

It is respectfully request the Applicant point out to the Examiner in the independent claim limitations the inventive concept and to particularly claim that in the claim language because limitations are not read from the Specification into the claims.

Conclusion

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Inquiries

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday-Thursday, 6:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert
May 12, 2005